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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,243	10/15/2001	Juan-Carlos Diaz	P842 CIP	4113

28390 7590 01/14/2005
MEDTRONIC VASCULAR, INC.
IP LEGAL DEPARTMENT
3576 UNOCAL PLACE
SANTA ROSA, CA 95403

EXAMINER

THALER, MICHAEL H

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 01/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/978,243

Applicant(s)

DIAZ, JUAN-CARLOS

Examiner

Michael Thaler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-10, 12-22 and 25-27 is/are allowed.
- 6) ☒ Claim(s) 1, 11, 23 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on Nov. 15, 2004 has been entered.

The disclosure is objected to because of the following informalities: The text on page 12, lines 6-10 is confusing and inaccurate since it indicates that section 96 contains the stent graft while section 98 maintains sealing of the fluid receiving chamber. It appears that reference numerals 96 and 98 are reversed from their proper locations in the text. In claim 1, line 35, "a" should be "said" since the fluid receiving section has already been claimed. Other independent claims have this problem. Appropriate correction is required.

Claims 1, 11, 23 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, lines 25-26, "has an inner surface...having a smooth inner surface" is confusing since it is not seen how one surface can have another

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surface. It is unclear if one or two surfaces are claimed. Claim 11 is indefinite for the same reason.

Claims 1, 11, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fiedler (5,817,101) in view of Bartholf et al. (2001/0034549). Fiedler, in figures 1-3, discloses catheter 22 having a guidewire lumen 24 and pressurizing lumen 26, fixed seal mount (the portion of catheter 22 which supports seal 38), sheath 36 having a movable seal mount (the portion of sheath 36 which supports seal 40), a stent retention portion of said sheath (the portion of sheath 36 which surrounds stent 50 prior to stent deployment), a stent retraction portion of said sheath (the proximal portion of sheath 36 which surrounds seal 38 prior to stent deployment), first seal structure 38 and second seal structure 40. Fiedler fails to disclose the stent retraction portion of the sheath as having an inner surface made of a material different from the material of an inner surface of the stent retention portion of the sheath. However, Bartholf et al. teach that a stent containment sheath should include several sections, best shown in figure 3, including a stent retention portion 63 which has an inner surface made of a first material (the stainless steel of braiding 77, noting that the surface of braiding 77 is an "inner surface" as broadly claimed since this surface is within the

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body of portion 63) which inherently has a lubricious surface quality and a stent retraction portion which has an inner surface made of a second material (the Teflon of layer 69) different from the first material. This arrangement has the apparent advantage of providing high strength to the sheath, due to the stainless steel of braiding 77. It would have been obvious to include this arrangement in the Fiedler sheath so that it too would have this advantage. As to the phrase "suitable for easy release of a stent contained therein" in claim 1, line 24, the lubricious surface of the stainless steel of braiding 77 does not interfere with the easy release of the stent contained therein and thus is "suitable for easy release of a stent contained therein" even though this lubricious surface does not directly contact the stent. Fiedler fails to disclose a "stent plunger" to provide a backing for the stent. However, Bartholf et al. teach that a stent should be supported or backed by a rigid stop 22 to prevent it from migrating proximally within the sheath during sheath retraction (paragraph [0028]). It would have been obvious to include a rigid stop on the Fiedler catheter 22, separate from flexible seal 38, so that it too would have this advantage. As to claim 23, Fiedler fails to disclose the distal portion of sheath as having a wall thickness which is different than the wall thickness of the

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proximal portion of the sheath. However, it is old and well known in this art to make the distal portion of a stent deployment sheath of a thickness which is smaller than the thickness of its proximal portion in order to facilitate its insertion and advancement through the vasculature. It would have been obvious to make the wall of the distal portion of sheath 36 thinner so that it too would have this advantage. The above well known in the art statement is taken to be admitted prior art because applicant failed to traverse the examiner's assertion (M.P.E.P. 2144.03).

Claims 2-10,12-22 and 25-27 are allowed.

Applicant's arguments filed Nov. 15, 2004 have been fully considered but they are not persuasive for the reasons set forth above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (571)272-4704. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571)272-4963. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

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mht

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A handwritten signature in black ink, appearing to read 'Michael Thaler', with a stylized flourish at the end.

MICHAEL THALER
PRIMARY EXAMINER
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